

09/317,156

REMARKS/ARGUMENTS

Claims 1, 4-11, 14, 15 and 17-25 are now active in this application.

The indication that claims 11, 14 and 15 are allowable, and that claims 4, 5, 7, 19, 20 and 22 would be allowable if rewritten to overcome the noted indefiniteness and to be in independent form including all the limitations of the base claim and any intervening claims is acknowledged and appreciated.

DOUBLE PATENTING REJECTION

Claims 1, 10 and 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of USPN 6,442,137.

To expedite prosecution, a terminal disclaimer is submitted herewith to overcome the obviousness-type double patenting.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103

I. Claims 1, 17 and 18 are rejected under 35 U.S.C. § 102(b) as being anticipated by Morris (USPN 5,390,184).

The rejections are respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into possession of one having ordinary skill in the art. *Helifix Ltd. v.*

09/317,156

Blok-Lok, Ltd., 208 F.3d 1339, 200 U.S. App. LEXIS 6300, 54 USPQ2d 1299 (Fed. Cir. 2000);
Electro Medical Systems S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048, 32 USPQ2d 1017
(Fed. Cir. 1994).

There is a significant difference between the claimed invention and the arrangement disclosed by Morris that scotches the factual determination that Morris identically describes the claimed inventions within.

Independent claim 1 recites, *inter alia*:

...the external memory interface including ***a scheduler for selectively assigning memory access slots to ports for access to the external memory...***

Independent claim 17 recites, *inter alia*:

...a scheduler for selectively assigning memory access slots to each of the ports for access to the second memory, the selectively assigning memory access slots to each of the ports being based on a selected one of the plurality of programmable system settings stored in the first memory...

Thus, each of independent claims 1 and 17 are concerned with a scheduler for selectively assigning memory access slots to each of the ports (of the network switch) for access to the external (second) memory.

USPN 6,442,137 has no disclosure or suggestion concerning a scheduler that selectively assigns memory access slots to each of the ports of the network switch for access to the external (second) memory.

09/317,156

The above argued difference between the claimed device vis-à-vis the device of Morris undermines the factual determination that Morris identically describes the claimed inventions within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1, 17 and 18 under 35 U.S.C. § 102 for lack of novelty as evidenced by Morris is not factually or legally viable and, hence, solicit withdrawal thereof.

II. Claims 6, 8-10, 21 and 23-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Morris in view of Daniel et al. (USPN 5,841,772).

The rejections are respectfully traversed.

Independent claims 1 and 17 are patentable over Morris, as note above. Therefore, claims 6 and 8-10 depending from claim 1, and claims 21 and 23-25 depending from claim 17 are patentable over Morris also, even when considered in view of Daniel et al.

09/317,156

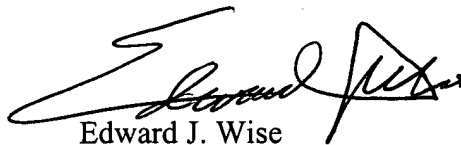
CONCLUSION

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY



Edward J. Wise
Registration No. 34,523

600 13th Street, NW
Washington, DC 20005-3096
(202) 756-8000 EJW/dmd
DATE: March 17, 2004
Facsimile: (202) 756-8087